UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/895,525	06/28/2001	Manoel Tenorio	020431.0843	8191

53184   7590   11/14/2008
i2 TECHNOLOGIES US, INC.
ONE i2 PLACE, 11701 LUNA ROAD
DALLAS, TX 75234

EXAMINER
CHEN, TE Y

ART UNIT	PAPER NUMBER
2161	

MAIL DATE	DELIVERY MODE
11/14/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *21 August 2008*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-37* is/are pending in the application.

 4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-37* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

 a)☐ All b)☐ Some * c)☐ None of:

  1.☐ Certified copies of the priority documents have been received.

  2.☐ Certified copies of the priority documents have been received in Application No. _____.

  3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

Response to Amendment

This office action is in response to the amendment filed on Aug. 21, 2008.

Claims 1-37 are pending for examination; claims 23 and 37 have been amended.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

As set forth in MPEP 21 06(II)A:

Identify and understand Any Practical Application Asserted for the Invention The claimed invention as a whole must accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." State Street, 149 F.3d at 1373, 47USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (Brenner v. Manson, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96),' In re Ziegler, 992, F.2d 1 197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 199334. Accordingly, a complete disclosure should contain some indication of the <u>practical application</u> for the claimed invention, i.e., why the applicant believes the claimed invention is useful.

Apart from the utility requirement of 35 U.S.C. 101, usefulness under the patent eligibility standard requires significant functionality to be present to satisfy the useful result aspect of the practical application requirement. See Arrhythmia, 958 F.2d at 1057, 22 USPQ2d at 1036. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make the invention eligible for patenting. For example, a claim directed to a word processing file <u>stored on a disk</u> may satisfy the utility requirement of 35 U.S.C. 101 since the information stored may have some <u>"real world"</u> value. However, the mere fact that the claim may satisfy the utility requirement of 35 U.S.C. 101 does not mean that a useful result is achieved under the practical application requirement. The claimed invention as a whole must produce a "useful, concrete and tangible" result to have a practical application.

The claimed invention is subject to the test of State Street, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02. Specifically State Street sets forth that the claimed invention must produce a "useful, concrete and tangible result". The Interim Guidelines for Examination of Patent Applications for Patent Subject Maher Eligibility states in section IV C. 2 b. (2) (on page 21 in the PDF format):

The tangible requirement does not necessarily mean that a claim must either be tied to a particular machine or apparatus or must operate to change articles or materials to a different state or thing. However, the tangible requirement does require that the claim must recite more than a §101 judicial exception, in that the process claim must set forth a practical application of

that §101 judicial exception to produce a real-world result. Benson, 409 U.S. at 71-72, 175 USPQ
at 676-77 (invention ineligible because had "no substantial practical application").

Claims 1-11 and 34-35, are rejected under 35 U.S.C. § 101 because the claimed

invention is directed to non-statutory subject matter.

As to claims 1-11 and 34-35, these system claims merely recited a data

association module having intended functional processing for manipulate one or more

seller databases in the claimed preamble, the claimed body lacks of any physical

hardware devices to actually perform the claimed intended utility to constitute a real

world application, as such, the whole system seems to be software per se, which

renders the claimed system as non-statutory.

To expedite a complete examination of the instant application the claims rejected

under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in

anticipation of applicant amending these claims to place them within the four statutory

categories of invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public
use or on sale in this country, more than one year prior to the date of application for patent in the United
States.

Claims 1-7, 9-18, 20-29 and 31-37, are rejected under 35 U.S.C. 102(b) as being anticipated by Call (U.S. Patent No. 6,154,738).

As to claims 1, 12, 23, and 34-37, Call discloses a computer-implemented system with method and executable program products for categorizing product data in an electronic commerce transaction [e.g., Abstract, Fig(s). 1-8 and associated texts] as claimed by applicant, comprising the following functions:

a data association module [e.g., the "Web register" module at Abstract, lines 14-20, Fig(s). 1- 8 and associated texts] coupled with one or more seller database [e.g., the reseller units: 105, 107 at col. 14, lines 43-55] and a global content directory server [e.g., the Internet light weight directory server at Abstract, lines 6-7, the shared sales Internet server at Abstract, line 16, the cross-reference product servers at Abstract, line 18, etc.], the data association module operable to:

a) access a first product classification schema, the first schema comprising a taxonomy that comprising a hierarchy of classes for categorizing one or more products [e.g., col. 11, lines 65- col. 12, lines 46], the first schema further comprising ontology associated with one or more of the classes [e.g., the use of XML metadata & Document Type Descriptor techniques at col. 25, lines 26 – 34, 53-66], each ontology comprising one or more product attributes, wherein each of the one or more products is associated with a global unique identifier [e.g., the use of universal product code cross-referencing schema with domain name services over an Internet at col. 21, lines 6 – col. 22, lines 53, Fig 6 and associated texts];

b) access target data to be associated with the first schema, the target data

organized according the a second product classification schema [e.g., col. 22, lines

55—col. 26, lines 27, the browser navigation processing of Fig. 6 and associated texts];

c) determine one or more classes of the first schema with which at least a portion

of the target data is associated based on a comparison between the target data and the

product attributes of the ontologies of the first schema or between the target data and

values for one or more of the product attributes of the ontologies of the first schema

[e.g., the use of cross-reference server at Fig(s). 3-4 and associated texts];

d) associate the at least a portion of the target data with one or more classes of

the first schema in response to determine, based on the automatic comparison, the one

or more classes of the first schema with which the at least a portion of the target data

should be associated. [e. g., the use of WWW consortium search engines with XML,

Xsl, Xpointer, XLink indexing schema at col. 25, lines 35 – col. 26, lines 27, col. 33,

lines 1-12]; and

e) store the values for the one or more of the product attributes of the ontologies

of the first schema with which the target data is compared in one or more seller

databases [e.g., col. 13, lines 45 – col. 14, lines 2, Fig(s). 3-7 and associated texts].

.

As to claims 2-6, 13-17 and 24-28, except the limitations recited in claims 1, 12,

and 23, Call further discloses that the determining one or more classes of the first

schema with which the at least a portion of the target data is associated comprises

identifying a portion of the target data via matching the name, the value, a range of

value, the symbol and formatting of a product attribute in the ontology of these one or more classes of the first schema [e.g., Call: Fig. 2 and associated texts, col. 11, lines 65 – col. 12, lines 57].

As to claims 7, 18 and 29, Call further discloses that determining one or more classes of the first schema with which the at least a portion of the target data is associated comprises using vector space analysis to identify multiple portions of the target data including values that correspond to values for multiple product attributes included in the ontologies of these one or more classes of the first schema [e.g., the use of LDAP in the product code cross-referencing schema in a vector domain name space col. 20, lines 30 - col. 21, lines 4].

As to claims 9-11, 20-22 and 31-33, Call further discloses using indicators to determine the association between the system classes and it's attributes and the indicators are pointers [e.g., the use of Xlinks, Xpointers of XML document at col. 24, lines 45-col. 25, line 13].

Claim Rejections - 35 USC § 103 (Continue)

Claims 8, 19 and 30, are rejected under 35 U.S.C. 103(a) as being unpatentable over Call et al. (U.S. Patent No. 6,154,738) in view of Sahai et al. (U.S. Patent No. 7,272,626).

As to claims 8, 19 and 30, Call did not specifically disclose determining one or more classes of the first schema with which the at least a portion of the target data is associated comprising using statistical correlation techniques to identify portions of the target data including values that correspond to values for a product attribute included in the ontologies of these one or more classes of the first schema.

However, Sahai et al. (hereinafter referred as Sahai) discloses using statistical correlation techniques to identify portions of the target data including values as claimed [e.g., Title, Abstract, col. 3, lines 21- col. 4, lines 34, Fig(s) 4-9 and associated texts].

Call and Sahai are of the same field of endeavor to dynamically identify target data with a product classification schema via the use of a global unique identifier in the XML document, hence, it would have been obvious for an ordinary skilled person in the art at the time the invention was made to apply the statistical technique disclosed by Sahai into the system of Call, because by doing so, the combined system will be upgraded to use the well-known statistical correlation techniques to identify portions of the target data including values that correspond to values for a product attribute included in the ontologies of these one or more classes of the first schema, such that the combined system will provide a more precise response to the user in a decentralized manner.

Response to Arguments

Applicant's arguments filed on Feb 21, 2008 have been fully considered but they are not persuasive.

A) Replay to the arguments against the 35 U.S.C. § 101 rejections:

As to claims 23 and 37, these claims have been amended to include "a computer-readable storage medium" which intended to overcome the specification and the 35 U.S.C. § 101 rejections of claims 23-33 and 37 on record, as such, the Office withdraws the specification objection the 35 U.S.C. § 101 rejections of claims 23-33 and 37 on record. In addition, the examiner regarded the claimed computer-readable storage medium merely represents non-volatile storage medium.

As to claims 1-11 and 34-35, the arguments against the 35 U.S.C. § 101 rejections of these claims have been fully considered, however, it is not persuasive. Because applicant failed to defined the metes and bounds of the claimed a global content directory server, which could represent a conceptual Internet server having software only. Thus, the rejections on record are maintained.

B) Replay to the arguments against the 35 U.S.C. § 102(b) rejections:

The examiner disagrees with applicant's arguments that Call failed to disclose the limitations as claimed: "accessing a first product classification schema, the first schema comprising a taxonomy comprising a hierarchy of classes for categorizing one or more products, the first schema further comprising ontologies associated with one or more of the classes, each ontology comprising one or more product attributes."

In responded to the above arguments, the examiner first points out that the claimed "first schema" was written in Markush format by the repeatedly open-ended phrases "comprising" for at least four times at lines 6-10 of claim 1, which renders the

metes and bounds of the claimed "first schema" widely open for reasonable art

interpretation. Further, the examiner directs applicant's attention to the following

excerpts and Fig.(s) disclosed by Call:

For example, at col. 11, lines 65 - col. 12, lines 46, Call clearly cited the following:

"By way of example, in the bookselling industry,
publishers, distributors, retailers, and libraries
often require a database of bibliographic information
which consists, for each book, of the book title,
author name(s), publisher's name, publication date,
type of book (hardcover, paperback, etc.), page count,
recommended retail price(s), and ISBN number (which
takes the form of a subpart of the EAN universal
product code). To the extent the content and format of
data records which describe particular classes of
products in particular industries and trade groups have
been previously adopted and placed in widespread use,
those structured data records may advantageously be
made available utilizing the present invention. This
is preferably achieved in two ways: a data record
(file) containing such field-structured information
about each product which is designated by a universal
product code is placed by the manufacturer in the
directory it creates for that product. This structured
data record is given a filename indicative of the
format used to store the structured data. For example,
each directory bearing a name corresponding to the EAN
number for a book would preferably contain a file named
"biblio.dat" which contains a single structured record
containing bibliographic data describing that book."

"In addition, the manufacturer would place a combined
file, also called "biblio.dat" in its root
backslash.upcinfo" directory which contains all of
the records for all of the products individually
described in the subdirectories which have that

structure in a single file. For most manufacturers,
these structured data files, both individual record
files in the subdirectories and the combined file in
the root directory, may be automatically created and
updated on a periodic or dynamic basis from the content
of the manufacturer's existing database. The use of a
single combined file at each server permits multi-
manufacturer databases to be created by first
retrieving the IP-addresses of all or part of the
cross-reference table 215, and then retrieving and
merging the combined data files from the "/upcinfo"
directories from each identified server.
Alternatively, when information about all of a given
manufacturer's products of a given type is not desired,
the needed individual structured data files can be
retrieved from the individual product directories."

"As described later in more detail, the information
which the manufacturer makes available can
advantageously be stored using the eXtensible
Markup Language (XML), which is also well suited for
providing metadata which defines and describes the
meaning of the various kinds of information that can
be provided about individual products, groups of
products, and the manufacturers and distributors from
which those products are obtained."

As set forth above, Call clearly depicted that his system accessed a first product

classification schema by using the content and format of data records as stored XML

metadata. Wherein, the first schema is deemed to include a taxonomy [e.g., "/upcinfo"

directories] which included a hierarchy of classes for categorizing one or more products

[e.g., the manufacturer would place a combined file, also called "biblio.dat" in its root

/upcinfo" directory which contains all of the records for all of the products individually

described in the subdirectories which have that structure in a single file.] In addition,

the use of a hierarchical domain name product code cross-referencing schema at col.

21, lines 6 – col. 22, lines 53, and Fig. 6 also disclosed the claimed limitations.

Moreover, the use of XML metadata & Document Type Descriptor (DTD) object

oriented modeling process in a Resource Description Framework (RDF) at col. 25,

lines 26 – 34, 53-66 further described the claimed limitations. As such, in contrary to

applicant's arguments, Call clearly anticipated the claimed invention.

C) Replay to the arguments against the 35 U.S.C. § 103(a) rejections:

As discussed above, because the Office action have clearly addressed the

features as recited in claims 1-7, 9-18, 20-29 and 31-37 under 35 U.S.C. § 102(b) and

combined the art of Sahai et al. (U.S. Patent No. 7,272,626) to successfully build a

reasonable Prima Facie case for the claims 8, 19 and 30, for which applicant arguments

based on the 35 U.S.C. § 102(b) is not persuasive.

Thus based on the discussion above, because applicant does not clearly point

out the patentable novelty which he or she thinks the claims present in view of the state

of the art disclosed by the references cited or the objections made. Further, applicant

does not show how the amendments avoid such references or objections. The

examiner concludes that the prior art read on the claimed features.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SUSAN Y. CHEN whose telephone number is (571)272-4016. The examiner can normally be reached on Monday - Friday from 7:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mofiz Apu can be reached on 571-272-4080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Susan Y Chen/
Partial Sig. Examiner
Art Unit 2161

November 12, 2008

/Apu M Mofiz/

Supervisory Patent Examiner, Art Unit 2161